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10/077,088	02/15/2002	Jean-Michel Marchon	88265-6488	3491

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PATENT DEPARTMENT  
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EXAMINER
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MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/077,088

Applicant(s)

MARCHON ET AL.

Examiner

Robert Madsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/15/02, 4/11/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 , drawn to a round frozen confectionery, classified in class 426, subclass 104.
  - II. Claims 10-20, drawn to a method of forming a round frozen confectionery, classified in class 426, subclass 516.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the recited round frozen confectioner can be made by another and materially different process, such rounding by hand instead of a forming head.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Allan Fanucci on March 11, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 10-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3,4,6 are rejected under 35 U.S.C. 102(b) as anticipated by Durst (US 4674968).

8. Regarding claims 1, 4, and 6, Durst teaches ice cream balls as recited in claim 4, without an apex, rough edges or forming tool marks wherein the cohesion would be greater than 95% (i.e. the total volume of the product is reduced by 1-5% when released from the rounding mold after the extrusion) as recited in claim 1, wherein the volume of the mold is 65.5-98.3 ml with a diameter of 50-57.3 mm (i.e. with a volume of 4-6 cuin) as recited in claim 6 (Column 1, line 50 to Column 2, line 26, Column 4, lines 53-65).

9. Regarding claim 3, Durst teaches the material is extruded through section 6 and the roundness is created by revolution of the blade (Column 3, lines 44-60 and Column 2, lines 58-61). Although Durst does not explicitly teach the recited temperature limitation at which the product is made, a product-by-process limitation. “[E]ven though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The product of Durst has the product characteristics recited in claim 3 and thus anticipates claim 3.

10. Claims 1,3,4 are rejected under 35 U.S.C. 102(b) as anticipated by Hector et al. (EP 0797392 B1).

11. Hector et al. teach an ice cream that is extrusion form and its roundness is generated by revolution, as recited in claim 3, in the form of a hollow sphere or “perfect ball shape”, as recited in claim 1 and 4 (See English Abstract, Figures 3-6,8,9,11, and English claims). With respect to the cohesion ratio, this has been defined as the ratio of the height of an item just before hardening and that at the outlet of the extrusion nozzle. Hector et al. inherently teaches greater than 95% since the balls are formed at the outlet extrusion nozzle. With respect to the recitation of the particular method of forming the balls in claim 3, Hector et al. teach extrusion wherein the roundness is created by revolution (of a scraper 10) but do not explicitly teach any particular temperature. However, as this is a product claim and the product of Hector appears to meet the product characteristics (e.g. roundness), Hector et al. anticipates claim 3. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

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product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

12. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Tarr (US 2716385)

13. Tarr '385 teach forming ice creams balls, as recited in claim 4, are free of an apex, rough edge or forming tool marks since they are (1) formed without a mold enclosure, (2) they are deposited into a container (item 14) having a base formed by a rounded cup (e.g. item 30) in which a circular blade (item 40) is rotated around the entire ball to provide a smooth edge and sever the ball from the container walls to remove the ball filled cup (Column 2, lines 35-66, Column 3, lines 19-30). Tarr '385 teaches the cohesion is greater than 95% since the height of the ice cream ball prior to hardening is the same as the height of the ice cream exiting the extruded portion (i.e. has a cohesion of 95% or greater), as recited in claim 1. This is illustrated by the blade reaches the upper portion of the container used to form the ball (i.e. Figure 2).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (US 4674968) as applied to claims 1,3,4,6 above.

16. Regarding claim 2, Durst teaches, as an example, ice cream with 50% overrun, and teaches the apparatus used can be modified through experimentation to allow for any particular percent overrun (Column 4, lines 53-65). Durst is silent in teaching 80-100% overrun. However, since ice cream with an 80-100% overrun is notoriously well known, the level of overrun effects the product texture, and Durst teaches an invention that is compatible with various overruns, to select any particular level of overrun would have been an obvious matter of choice depending on the desired texture.

17. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (US 4674968) as applied to claims 1,3,4,6 above, further in view of Jadraque et al. (US 6025003).

18. Durst teaches the mold may be in any shape (Column 3, lines 50-60, Column 6, lines 15-32), but are silent in teaching a lemon, strawberry, or pear. Jadraque et al. teach it is desirable to make ice cream molds into complex shapes such spheres as well as fruit shapes, including a lemon shape (Column 1, lines 15-20 Example 2). Therefore, it would have been obvious to modify Durst and include a lemon shape since Jadraque et al. teach it is desirable to form lemon shaped ice cream and one would have been substituting one conventional ice cream mold design for another. Furthermore to select any particular dimensions (i.e. 30-40 mm and volume of 14-25ml) would have been an

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obvious matter of design choice depending on (1) the desired portion size and (2) if it is desired to have the ice cream to not only simulate a lemon shape, but a lemon size as well.

19. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (US 4674968) as applied to claims 1,3,4,6 above, further in view of Raitt (US 3817422).

20. Durst teaches the ice cream balls may be placed in a tray (Column 2, lines 45-50), but is silent in teaching packing into cells in strips of thermoplastic material enclosed by a cardboard box.

21. Raitt teaches a method of packaging ice cream balls conveniently in plastic strips so that one can sell individual, uniformly sized ice cream servings (Column 1, lines 1-26). Raitt teaches placing the strips in boxes (Column 3, lines 31-50). Therefore, it would have been obvious to modify the tray packed product of Durst and include the product in thermoplastic strips with cardboard boxes since Raitt teaches this a convenient way to pack and sell individual ice cream balls and one would have been substituting one ice cream ball collection container for another .

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alheit (US 2444486), Tarr (US 2638065), Salerno (US 2851967), and Beer (US 4767307) teach forming spherical ice cream.



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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen  
Examiner  
Art Unit 1761



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